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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,406	09/01/2006	Tomihisa Kamada	448252001800	2523

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MORRISON & FOERSTER LLP  
425 MARKET STREET  
SAN FRANCISCO, CA 94105-2482

EXAMINER
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DAGLAWI, AMAR A

ART UNIT	PAPER NUMBER
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2618

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/591,406	<b>Applicant(s)</b> KAMADA, TOMIHISA	
	<b>Examiner</b> Amar Daglawi	<b>Art Unit</b> 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 September 2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/01/2006</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 4-6 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly. These limitations help to avoid undue confusion in determining how many prior claims are actually referred to in a multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 4-6 not been further treated on the merits.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 7-13, 15-31 are rejected under 35 U.S.C. 102(b) as being anticipated by (EP 0950 968 A1).

With respect to claim 1, Takayama discloses a wireless communication terminal synchronization method in which data stored in a memory in each of plural wireless communication terminals is synchronized with each other, when a user selectively utilizes the plural wireless communication terminals by using a single subscriber information card, at least communicating operation in each of the wireless

communication terminals being enabled by mounting thereon the subscriber information card that records subscriber information, the method comprising the steps of:

uploading from a first wireless communication terminal with the subscriber information card being mounted, to a server via a communication network, at least updated part of data which is stored in a memory in the wireless communication terminal, in accordance with a user's request or automatically (Fig.1, #100, #110, abstract, par [2106;2109];

updating contents in a user's data storage area with the data being uploaded, in the server (par [2111]);

downloading the data to a second wireless communication terminal via the communication network from the server, the data being confirmed in accordance with a user's request or automatically, as data to be downloaded to the second wireless communication terminal from the server, after the subscriber information card having been demounted is mounted on the second wireless communication terminal (Fig.1, par [2111; 2115]); and

updating the contents of the memory in the second wireless communication terminal, with the data having been downloaded from the server (par [2115]) [the updating process always occurs when attaching or removing the SIM card in the reader/writer].

With respect to claim 2, Takayama further teaches uploading is allowed to be executed at least under conditions that the user is confirmed to be an authenticated

user of said subscriber information card and an authenticated user of the terminal (par [2109;2112], par [2115]) [The confirmation occurs when attaching the SIM card to the terminal].

With respect to claim 3, Takayama further teaches uploading is allowed to be executed at least under conditions that the wireless communication terminal that requested the uploading is confirmed to be a terminal being associated with said subscriber with said subscriber information card in advance (par [2109;2112, par [2115])).

With respect to claim 7, Takayama discloses A wireless communication system comprising plural wireless communication terminals at least communication operation of which is enabled by mounting a subscriber information card recording subscriber information, and a server that is connected with the wireless communication terminals via a communication network, said server comprising:

a communication means which performs data communication with said wireless communication terminals via the communication network (Fig.1, #110, par [2106; 2109]).

a storage unit which includes a storage area to store a copy of the data stored in said plural wireless communication terminals (Fig.140, #14000, par [2106; 2109]); and a server side synchronization means which synchronizes the data of a user stored in the wireless communication terminal and stored in the storage unit according to a request from said wireless communication terminal (Fig.1, #110; par [2106;2109]) [ When

attaching SIM card to a different terminal data is downloaded and synchronization (data consistency between the plural mobiles) of the data is achieved];

each of the wireless communication terminals comprising:

a card mounting means which detachably mounts a subscriber information card (Fig.140, #14001);

a wireless communication means which is operable when said subscriber information card is mounted (Fig.140; #14001; par [2111; 2112];

a memory means (Fig.140, #1501) which stores user data; and a terminal side synchronization means (Fig.140, #14000) which requests execution of synchronization to said server after said subscriber information card is mounted, and uploading or downloading of data is executed with said server as required (par [2106; 2115]); and at least either one of said server and each of said wireless communication terminals further comprising:

an authentication means (SIM card, Fig.140, #14000) which allows only plural wireless communication terminals possessed by an identical user, to perform synchronization as to the user data of the user in the storage unit of said server (par [2106;2109]; par [2111;2115]).

With respect to claim 8, Takayama further discloses said authentication means allows synchronization to be executed at least under conditions that the user who requested the synchronization is confirmed to be an authenticated user of said

Subscriber information card and a an authenticated user of the terminal (par [2109; 2112], par [2115]) [The confirmation occurs when attaching the SIM card to the terminal].

With respect to claim 9, Takayama further discloses said authentication means confirms that the user of the terminal that requested the synchronization is an authenticated user of said subscriber information card on the basis of personal identification information being associated with said subscriber information card (par [2109; 2112], par [2115]).

With respect to claim 10, Takayama further teaches authentication means (SIM card) confirms that the user is an authenticated user of the terminal on the basis of personal identification information being associated with the wireless communication terminal (par [2109; 2112], par [2115]).

With respect to claim 11, Takayama further teaches authentication means allows executing the synchronization under conditions that the terminal that requested the synchronization is confirmed to be the terminal that is associated with the subscriber information card in advance (par [2109; 2112], par [2115]) [The confirmation occurs when attaching the SIM card to the terminal].

With respect to claim 12, Takayama further teaches authentication means is provided in the terminal so as to store in a memory of the terminal the subscriber information card, and in performing authentication, it is checked whether the subscriber identification information of the subscriber information card mounted on the wireless

communication terminal and the subscriber identification information stored in the memory of the terminal as a target for authentication match with each other, thereby confirming that the terminal requested the synchronization is a terminal being associated with said subscriber information card in advance (par [2109; 2115]).

With respect to claim 13, Takayama further teaches said authentication means is provided in the terminal so as to store in the memory of the subscriber information card mounted on the terminal, the terminal identification information recorded in the terminal, and in performing authentication, it is checked whether any of the plural terminal identification information stored in the memory of the subscriber information card and the terminal identification information recorded in the terminal as a target of the authentication match with each other, thereby confirming that the terminal requested the synchronization is a terminal being associated with the subscriber information card in advance (par [2109;2115]) [The confirmation occurs when attaching the SIM card to the terminal].

With respect to claim 15, Takayama discloses A wireless communication terminal at least communication operation of which is enabled by mounting a subscriber information card that records subscriber information, said terminal comprising:

a card mounting means which detachably mounts a subscriber information card (Fig.140, #14002);

a wireless communication means which is operable when the subscriber information card is mounted (Fig.1, #140; #1517)



a memory means which stores user data (Fig.1, #1501); and a terminal side synchronization means (Fig.140, #14000) which requests execution of synchronization to the server on the communication network after the subscriber information card is mounted, and executes uploading or downloading of data with the server as required (Fig.140, par [2106;2115]).

With respect to claim 16, Takayama further teaches authentication means (SIM card) which allows only plural wireless communication terminals possessed by an identical user to perform synchronization for the user data of the user in a storage unit in said server (Fig.140, #14000, par [2111;2115]).

With respect to claim 17, Takayama further teaches said authentication means allows the synchronization to be executed under conditions that the user of the terminal who requested the synchronization is confirmed to be an authenticated user of said subscriber information card and the user is confirmed to be an authenticated user of the terminal (par [2109; 2112], par [2115]) [The confirmation occurs when attaching the SIM card to the terminal].

With respect to claim 18, Takayama further teaches said authentication means confirms that the user of the terminal that requested the synchronization is an authenticated user of said subscriber information card on the basis of personal Identification information being associated with said subscriber information card (par [2109; 2112], par [2115]).

With respect to claim 19, Takayama further teaches authentication means (SIM card) confirms that the user is an authenticated user of the terminal on the basis of personal identification information being associated with the wireless communication terminal (par [2109; 2112], par [2115]).

With respect to claim 20, Takayama further teaches authentication means allows executing the synchronization under conditions that the terminal that requested the synchronization is confirmed to be the terminal that is associated with the subscriber information card in advance (par [2109; 2112], par [2115]) [The confirmation occurs when attaching the SIM card to the terminal].

With respect to claim 21, Takayama further teaches authentication stores in a memory means of the wireless communication terminal, the subscriber identification information recorded in said subscriber information card and performing authentication, it is checked whether the subscriber identification information of the subscriber information card mounted on the wireless communication terminal and the subscriber identification information stored in the memory means of the terminal as a target for authentication match with each other, thereby confirming that the terminal requested the synchronization is a terminal being associated with said subscriber information card in advance (par [2109;2115]).

With respect to claim 22, Takayama further teaches said authentication means stores the terminal identification information recorded in the terminal in the memory in the subscriber information card mounted on the terminal, and in performing

authentication, it is checked whether any of the plural terminal identification information stored in the memory in the subscriber information card and the terminal identification information recorded in the terminal as a target of the authentication match with each other, thereby confirming that the terminal requested the synchronization is a terminal being associated with the subscriber information card in advance (par [2109;2115]) [The confirmation occurs when attaching the SIM card to the terminal].

With respect to claim 23, Takayama further teaches a detecting means (Fig.140, #14002) which detects mounting and/or demounting of said subscriber information card, wherein, said terminal side synchronization means (SIM card, Fig.140, 14000) accesses said server triggered by detecting the mounting and/or demounting of said subscriber information card, and requests execution of the synchronization (par [2111;2115]).

With respect to claim 24, Takayama further teaches said terminal side synchronization means accesses said server triggered when the battery remaining amount becomes a predetermined level or less and requests execution of synchronization including at least data uploading (par [2113;2117]).

With respect to claim 25, Takayama further teaches said terminal side synchronization means is provided with a judging means which judges whether or not the terminal or not the terminal is in idle state and executes the synchronization process when said judging means determines that the terminal is in idle state (par [2106;2108]).

With respect to claim 26, Takayama further teaches said terminal synchronization means accesses said server in response to a directive from a user and

uploads data as a target for uploading and then erases a predetermined data in the terminal all at once (par [2106; 2108]).

With respect to claim 27, Takayama discloses A server being connected via a communication network with plural wireless communication terminals at least communication operation of which is enabled by mounting thereon a subscriber information card that records subscriber information, said server comprising:

a communication means which performs data communication with said wireless communication terminals via the communication network (Fig.140, #110);

a storage unit which has a storage area to store a copy of the data that is stored in said plural wireless communication terminals (Fig.140, #14000, par [2106; 2109]); a server side synchronization means which performs synchronization with said wireless communication terminals for user data stored in said storage unit, in accordance with a request from said wireless communication terminals (Fig.1, #110, par [2106; 2109]) [when attaching SIM card to a different terminal data is downloaded and synchronization is achieved]; and

an authentication means (Fig.140, #14000) which allows only plural wireless communication terminals possessed by an identical user to perform synchronization for the user data of the user in the storage unit (par [2111;2115], par [2106;2109]).

With respect to claim 28, Takayama further discloses said authentication means allows synchronization to be executed at least under conditions that the user who requested the synchronization is confirmed to be an authenticated user of said Subscriber information card and a an authenticated user of the terminal (par [2109; 2112], par [2115]) [The confirmation occurs when attaching the SIM card to the terminal].

With respect to claim 29, Takayama further discloses said authentication means confirms that the user of the terminal that requested the synchronization is an authenticated user of said subscriber information card on the basis of personal identification information being associated with said subscriber information card (par [2109; 2112], par [2115]).

With respect to claim 30, Takayama further teaches authentication means (SIM card) confirms that the user is an authenticated user of the terminal on the basis of personal identification information being associated with the wireless communication terminal (par [2109; 2112], par [2115]).

With respect to claim 31, Takayama further teaches authentication means allows executing the synchronization under conditions that the terminal that requested the synchronization is confirmed to be the terminal that is associated with the subscriber information card in advance (par [2109; 2112], par [2115]) [The confirmation occurs when attaching the SIM card to the terminal].

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 14 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama (EP 0950 968 A1) in view of Utsumi (US 2005/0125344 A1).

With respect to claims 14 and 32, Takayama teaches all the limitations of claims 7 and 31 except for a server comprises subscriber managing database to register the subscriber identification information of the subscriber information card and terminal identification information of plural wireless communication terminals of the user in such a manner as being associated with each other; said authentication means receiving from the wireless communication terminal, subscriber identification information recorded in said subscriber information card and terminal identification information of the wireless communication terminal on which the subscriber information card is

mounted, and confirming that the terminal identification information thus received is registered in the subscriber managing database, in such a manner as being associated with the subscriber identification information thus received, thereby confirming that the terminal that requested the synchronization is a terminal that is associated with said subscriber information card in advance which is taught in related art by Utsumi (See par [0011]).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the teachings of Takayama to incorporate a server and a plurality of member-users and a database as taught by Utsumi so as to provide personal information verification method in an electronic commerce system.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
8. Yaqub et al (US 2004/0180657 A1) teaches an authenticating multiple devices simultaneously using a single wireless subscriber identity module.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amar Daglawi whose telephone number is 571-270-1221. The examiner can normally be reached on Monday- Friday (7:30 AM- 5:00 AM).

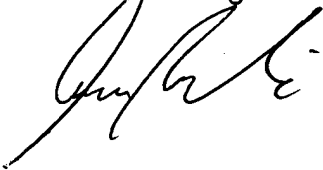
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lana N. Le can be reached on 571-272-7891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amar Daglawi



01-07-08

LANA LE  
PRIMARY EXAMINER